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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,001	11/17/2000	Jay S. Walker	00-069	7526

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STAMFORD, CT 06905

EXAMINER

TRAN, KHOI H

ART UNIT PAPER NUMBER

3651

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,001

Applicant(s)

WALKER ET AL.

Examiner

Khôi H Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,9,16 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,10-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's Request for Reconsideration of the Restriction Requirement filed on May 10, 2004, has been considered. The Restriction Requirement is still deemed proper and is therefore made FINAL. Answers to Applicant's points are indicated below.

- 1) Reasonable example of recited material differences was provided in paragraph 2 of the Restriction Requirement.
- 2) See the last line of paragraph 2 in the Restriction Requirement for cited example.
- 3) "burdensome" argument is not germane in a Species Requirement. See MPEP 806.05. Separate status in the art shown by different classifications, as indicated in paragraphs 1-3 of the Restriction Requirement, is sufficient proof of burden. In addition, while there may or may not be overlapping searches for each of the defined inventions, the divergent subject matter contained in the nonelected group(s) or invention(s) would warrant significant additional consideration if addressed on the merits.
- 4) Separate status in the art shown by different classifications, as indicated in paragraphs 1-3 of the Restriction Requirement, is sufficient proof of burden.
- 5) See MPEP 806.04 (e).
- 6) See MPEP 806.04 (e).

7) MPEP 806.05 (c) indicates that if one-way distinctness can be shown to support that the process as claimed can be practiced by another material different apparatus, the apparatus and method claims can be restricted. MPEP 806.05 (c) does not indicate that if the claims are broadly recited to cover other inventions, they should all be examined.

8) Why would claims 28 and 35 be linking claims, as indicated by Applicant? Which grouping of claims are they linking? See MPEP 806.05 (e).

9) see 8) above.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

The method step of selecting the information item **before** (emphasis added) the offering step must be shown or the feature canceled from claim 2. No new matter should be entered.

The method step of providing the offering **before** (emphasis added) the payment-receiving step must be shown or the feature canceled from claim 6. No new matter should be entered.

The method step of providing change only if the information item is not accepted must be shown or the feature canceled from claim 8. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-6, 8, 10-15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satchell, Jr. et al. 5,822,216.

Satchell '216 discloses a method of operating a soda bottle vending machine per claimed invention. The method comprises receiving a payment via cash or credit card for a product. The method comprises receiving a product selection via push button on the vending machine (Figure 1). The method comprises dispensing a product selected by the product selection. The method comprises selecting an information item, i.e. a particular Internet websites, (Figures 9-13). The method comprises offering information items, i.e. news, financial information, music, from the accessed websites (Figures 9-13). The method comprises audibly reproducing said information item, i.e. music files, at said vending machine. The method also comprises transmitting the information item from an accessed website to a remote suitable receiver capable of receiving and utilizing said information item (column 5, lines 14-18). However, Satchell '216 is silent as to the specific of sending said accessed information to an e-mail address.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have sent any information items from any accessed websites on Satchell '216 vending machine to any particular e-mail addresses for

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access and utilization thereof because sending information data from a website to a particular e-mail address is commonly well known in the art. The process of sending e-mail via a web site would obviously involve providing destination addresses.

In regards to claims 6 and 13, Satchell '216 vending machine provides commercial offerings before payment is received.

In regards to claim 8, Satchell '216 vending machine provides change after a user decided not to accept said information item.

In regards to claims 17-19, Satchell '216 vending machine provides a menu of information items to a customer on a touch screen display device.

In regards to claim 20, it is obvious that a prompt for the entering of an address is required if a user of a particular website decided to forward the information therein to an e-mail location.

In regards to claim 21, Satchell '216 vending machine provides listing of prices for the information items.

Response to Arguments

5. Applicant's arguments filed May 10, 2004 have been fully considered but they are not persuasive.

In regards to the Drawings Argument, Applicant kept referring to the specification in the attempt to overcome the drawing objections. This argument is not persuasive. The reason why the drawings are objected is because the claimed invention is not shown in the drawings. Does Figure 9 actually show all of the claimed method steps of claim 2?

In regards to 35 USC 103 rejection arguments, Applicant argued that the rejection via Satchell, Jr. et al. 5,822,216 is relied upon unsupported assertion and motivation. Applicant argued that the commonly well-known feature of providing e-mailing capability to an Internet Web site is not supported. Enclosed is a list of US Patents that would support the notion that it is well known to provide e-mailing capability to Internet Web sites. One commonly well-known example is the Yahoo Web site that offers e-mailing capability to users.

See US PN 6,07,570; 6,341,314; 6,449,658; 6,615,241; 6,636,733; 6,708,203.

In conclusion, Satchell '216 allows users to access Internet Web sites. E-mailing capability on the Web sites of Satchell '216 vending machine would have been obvious, since it is commonly well known for Web providers to have offered e-mailing services to their users. Furthermore, the process of sending e-mail via web sites would obviously involve providing destination addresses.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

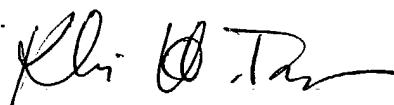
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H Tran whose telephone number is (703) 308-1113. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (703) 308-1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
07/06/2004